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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,903	03/31/2004	Young Sung Kim	HI-0194	4999

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EXAMINER

PATEL, ASHOK

ART UNIT PAPER NUMBER

2879

DATE MAILED: 10/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,903

Applicant(s)

KIM ET AL.

Examiner

Ashok Patel

Art Unit

2879

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-9 and 16-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. Applicant's election with traverse of Group I, Species II, claims 10-15, in the reply filed on 07/11/2006 is acknowledged. The traversal is on the ground(s) that search and Examination of entire application should be made without serious burden. This is not found persuasive because the inventions of Group I is distinct from that of Group II, as mentioned in the last restriction requirement. The Examiner noted that applicant did not challenge Examiner's restriction requirement in terms of technicality (distinctness among groups I and II). Also there would be a serious burden in searching both Groups I and II, since search required for Groups I and II are in two different classification areas. With respect to Species I and II, the both species includes uncommon subject matter therein. One species includes a subject matter of electromagnetic wave shield, whereas another species includes subject matter of at least two optical filter films and an adhesive. These two species includes uncommon/distinct subject matters. The Examiner further noted that applicant did not challenge Examiner's Species in terms of technicality (distinctness among Species I and II).

An action on merits including Group I, species II, claims 10-15 is as follow. Claims 1-9 and 16-20 are withdrawn from consideration. The requirement is still deemed proper and is therefore made FINAL.

2. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 13, lines 1-2, the term "the optical filter" lacks proper antecedent basis. The base claim 10 recited "at least two filters" (in plural form), whereas claim 13 recited a single optical filter film.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).35

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4. Claims 10, 11, 13, 14 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al (USPN Re37183).

As to claim 10, Kawamura et al disclose applicant's claimed front filter (Figure 3) including: an optical filter film (2) an adhesive layer (the shaded layer) having the conductive powder decentralized therein, for adhering the optical filter film.

Kawamura et al differ from applicant's claimed filter in that Kawamura et al disclose one optical filter as opposed to applicant's claimed two optical films and the adhesive layer adhering the two optical films to each other.

However providing an additional optical filter film within the filter would have been obviously a matter of alternative design choice since providing the claimed two optical layers do not solve any particular problem that is not solved by single optical filter of the prior art filter. Further providing the two optical filters films is also in the art.

In light of this, it would have been obvious to one of ordinary skill in the art to provide Kawamura et al's optical filter including additional optical filter film as a matter of alternative design choice.

Regarding claim 11, applicant is claiming the front filter wherein the conductive powder has a concentration of 1-40% of the synthetic resin by a volume ratio. Kawamura et al do not

disclose such concentration range. However, it would have been obvious to one of ordinary skill in the art to select conductive powder in a desired concentration range, since it has been held that where general conditions of the claim are discovered in the prior art, discovering the optimum or workable range of the concentration of the conductive powder involves only routine skill in the art. In re Aller, 105 USPQ 233.

As to claim 13, Kawamura et al disclose the optical filter being an antireflection coating (6).

As to claim 14, Kawamura et al do not disclose the conductive powder formed of any one element from applicant's claimed different elements. However, it would have been obvious to one of ordinary skill in the art to select any known and functionally equivalent conductive powder within the optical filter. In light of this, it would have been obvious to one having ordinary skill in the art to provide the Kawamura et al's optical filter including any known suitable conductive powder for neutralizing static electrical charges and/or for shielding the electromagnetic-wave within the filter.

As to claim 15, Kawamura et al do not disclose the conductive powder having size as claimed by applicant. However, it would have been obvious to one of ordinary skill in the art to select conductive powder having desired particle size, since

it has been held that where general conditions of the claim are discovered in the prior art, discovering the optimum or workable range of the particle size involves only routine skill in the art. In re Aller, 105 USPQ 233.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawamura et al, as applied to claim 10, in view of Applicant's admitted prior art.

As to claim 12, although Kawamura et al disclose the use of conductive particles within the filter for neutralizing static electrical charges, Kawamura et al do not disclose the electromagnetic-wave shield film having a conductive powder therein, as claimed by applicant.

However, since applicant's admitted prior art teaches of shielding of the electromagnetic-waves by providing electromagnetic-wave shield film, and since Kawamura et al teach the conductive powder for neutralizing static electrical charges, it would have been obvious to one having ordinary skill in the art to provide the electromagnetic-wave shield film, as taught by applicant's admitted prior art with the conductive particles, as taught by Kawamura et al for shielding the electromagnetic-wave.

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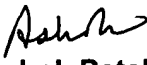
6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Koike et al, Iwasaki, Sugimachi et al and Tang et al each are cited for showing a general structure of a optical filter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ashok Patel whose telephone number is 571-272-2456. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nimesh Patel can be reached on 571-272-2457. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ashok Patel
Primary Examiner
Art Unit 2879